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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/388,191	09/01/1999	MARK G. DREYER	27600/M195A	3487
29471	7590	10/20/2005	EXAMINER	
MCCRACKEN & FRANK LLP 200 W. ADAMS STREET SUITE 2150 CHICAGO, IL 60606			PAULA, CESAR B	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 10/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/388,191

Applicant(s)

DREYER ET AL.

Examiner

CESAR B. PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to the RCE filed on 7/21/2005.

This action is made Non-Final.

2. In the amendment, claims 1-26 are pending in the case. Claims 1, and 16 are independent claims.

3. The rejections of claims 1-3, 5-9, 11-21, and 24-26 rejected under 35 U.S.C. 102(b) as being anticipated by Simpson, A., hereinafter Simpson, Sybex, 1993, pp.539-579, 852-859 have been withdrawn as necessitated by the amendment.

4. The rejections of claims 4, and 22 rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson have been withdrawn as necessitated by the amendment.

5. The rejections of claims 10, and 23 rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson, in view of Cohen, and further in view of Mastie (Pat. # 6,480,866, 11/12/02, filed on 6/30/98) have been withdrawn as necessitated by the amendment.

Drawings

6. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-9, 11-22, and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson, A., hereinafter Simpson, Sybex, 1993, pp.539-579, 852-859, in view of Hohensee et al, hereinafter Hohensee, (USPat.# 6,407,821 B1, 6/18/2002, filed on 9/8/1998).

Regarding independent claim 1, Simpson discloses using Wordperfect for the conversion of an ASCII comma-delimited text (csv) file—*first page description file*-- (fig.25.3) into a Wordperfect formatted secondary merge file, which contains part of the data in the csv file plus additional formatting data (fig.25.4). The secondary merge file—*first page description file*-- contains records and fields to be inserted or merged into a primary merge file to produce a third document —*second page description file* (pages 855, 540, lines 1-30).

Moreover, Simpson teaches using Wordperfect for the creation of a primary merge file—*template*-- having commands telling Wordperfect exactly where to place variable text (page 553).

In addition, Simpson discloses using Wordperfect for the conversion of the csv file—*first page description file*-- (fig.25.3) into a Wordperfect formatted secondary merge file—*database*

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for storing the data indicative of the portions of the first page description file--, which contains part of the data in the csv file plus additional formatting data—*extraction of data from the first page description file* (fig.25.4, page 855).

Furthermore, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file—*database--* to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4). Simpson fails to explicitly disclose: *Wherein the first page description file includes at least layout information for at least one page*. However, Hohensee discloses extracting the body of a pdf file and placing it in a database (col.10, lines 21-30). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Simpson, and Hohensee, because the benefit of avoiding redundant downloading of resources (col.3, lines 1-15).

Regarding claim 2, which depends on claim 1, Simpson discloses generating a primary merge file—*template*—with commands or placeholders for indicating location where variable information is to be placed (page 540, lines 7-30, fig. 16.1).

Regarding claim 3, which depends on claim 2, Simpson discloses an Wordperfect —*page make-up application program--* for generating the primary merge file—*template*—with commands or placeholders for indicating location in the primary merge file where variable information is to be placed (pages 539, 540, lines 7-30, fig. 16.1).

Regarding claim 4, which depends on claim 1, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file—*database*—(extracted from the csv file), to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4). Simpson fails to explicitly disclose: *page make-up software application comprises QuarkXPress*. However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have included QuarkXPress, because Simpson teaches the automatic printing of personalized documents using a basic list of names and addresses which can be used over and over. Thus, providing the benefit of printing personalized document as often as a user needs without ever retyping a single name or address using an application such as *QuarkXPress*.

Regarding claim 5, which depends on claim 1, Simpson teaches using Wordperfect for the creation of a primary merge file—*template*-- having commands telling Wordperfect exactly where to place variable text extracted from the data found in the csv file—*first page description file*-- (page 553, 855, fig. 25.3-4).

Regarding claim 6, which depends on claim 1, Simpson discloses using Wordperfect for the conversion of the csv file—*first page description file*-- (fig.25.3) into a Wordperfect formatted secondary merge file—*database*--, which contains a plurality of Wordperfect formatted fields with the data found in the csv file—*characterizing each portion of the portions of the first page description file* (fig.25.3-4, page 855).

Regarding claim 7, which depends on claim 1, Simpson discloses the conversion of a plurality of data records, fields and respective format —*first data portion and second data portion*-- from csv format to Wordperfect format, which contains the fields, and records separated from each other within a file (page 855, fig.25.3-4).

Regarding claim 8, which depends on claim 7, Simpson discloses the storage of a csv file, which contains data separated by commas and “CR/LF” commands—*content and control data*-- (page 855, fig.25.3).

Regarding claim 9, which depends on claim 8, Simpson discloses the conversion of a plurality of data records, fields and respective format from csv format to Wordperfect format using a “File Open” menu on a gui of the application (page 855, fig.25.3-4).

Regarding claim 11, which depends on claim 1, Simpson discloses the merging of two files, a primary merge file, such as form letters, mailing label, packing slip, etc.—*templates*-- A secondary merge file—*database*—containing records indicating information to be inserted into the primary merge files (page 540, lines 1-30, fig.25.3).

Regarding claim 12, which depends on claim 1, Simpson discloses the storage of a csv file —*image file*--, which contains data, such as “date, expense, amount...” —*image elements*-- which are displayed as font image on a computer screen separated by commas and “CR/LF” commands (page 855, fig.25.3).

Regarding claim 13, which depends on claim 12, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file—*database*—(extracted from the csv file), to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4).

Regarding claim 14, which depends on claim 1, Simpson teaches the merging of the primary merge file—*template*—and the Wordperfect formatted secondary merge file—*database*—(extracted from the csv file), to produce a third document —*second page description file* (pages 855, 540, lines 1-30, 554-556, fig. 25.3-4). In other words, the data in the secondary merge file is transferred to the primary merge file—*modifying the data stored in the database*-- and then a third file is produced after the transfer. The data in the secondary merge file is no longer located just in the database.

Claim 15 is directed towards a software system for implementing the software found in claim 14, and therefore is similarly rejected.

Claims 16-21, 24-26 are directed towards a method for implementing the system found in claims 1, 3, 5-8, 11-12, and 14 respectively, and therefore are similarly rejected.

Claim 22 is directed towards a method for implementing the system found in claim 1, and therefore is similarly rejected.

9. Claims 10, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson, in view of Hohensee, further in view of Cohen, and further in view of Mastie (Pat. # 6,480,866, 11/12/02, filed on 6/30/98).

Regarding claim 10, which depends on claim 1, Simpson discloses the merging of two files, a primary merge file, such as form letters, mailing label, packing slip, etc.—*templates*-- A secondary merge file containing records indicating information to be inserted into the primary merge files (page 540, lines 1-30, fig.25.3). Cohen fails to explicitly disclose: *plurality of pages to be printed in a book*. However, Mastie teaches the printing of a plurality of pages in a book (c.4,L.14-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Simpson, and Mastie, because Mastie teaches above the creation of a book onto a single document which can be printed, stored, retrieved, etc.

Claim 23 is directed towards a method for implementing the system found in claim 10, and therefore is similarly rejected.

Response to Arguments

Applicant's arguments filed 6/28/2004 have been fully considered but they are moot in light of the newly found prior art. Regarding claims 1, and 16, the Applicants indicate that none of the prior art teaches or suggests the newly introduced claim limitation (pages 7-8). The

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Applicants are directed towards the rejection of the amended limitation in light of the newly found prior art above.

Conclusion

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (571) 272-4128. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong, can be reached on (571) 272-4124. However, in such a case, please allow at least one business day.


Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, go to <http://portal.uspto.gov/external/portal/pair>. Should you have any questions about access to the Private PAIR system, please contact the Electronic Business Center (EBC) at 866 217-9197 (toll-free).

Any response to this Action should be mailed to:
Commissioner for Patents
P.O. Box 1450

Alexandria, VA 22313-1450

Or faxed to:

- (571)-273-8300 (for all Formal communications intended for entry)


CESAR PAULA
PRIMARY EXAMINER

10/17/05